

Appln No. 09/575,193
Amdt. Dated July 26, 2005
Response to Office Action of July 1, 2005

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REMARKS/ARGUMENTS

1. The Applicant has carefully considered the official communication dated July 1, 2005. Applicant respectfully submits that the following remarks are fully responsive to the official communication.
2. The Examiner has rejected claims 1-2, 4-5, 7, 11, 15, 18, 26, 31-34, 37, 45, 61 under 35 U.S.C. 103(a) as being unpatentable over "Intelligent Paper".
3. The following remarks address claims 1, 26 and 31, which are all independent. It follows that the remarks are relevant to the remaining claims by dependency.
4. Applicant has considered MPEP 2141 and respectfully reminds the Examiner of the provisions of *Hodosh v Block Drug Co. Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed Cir. 1986) in which it was held that when applying 35 USC 103, the following tenets of patent law must be adhered to:
 - (a) The claimed invention must be considered as a whole;
 - (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
 - (c) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
 - (d) Reasonable expectation of success is the standard with which obviousness is determined.
5. The Examiner has stated that:
 - 5.1. "Intelligent Paper discloses a system for providing printed information to a user from a DB storage device, the system including a user printer module connected to the network, for interfacing the user with the system, the module being responsive to the user requesting first information from the first DB for generating a first printed medium that displays the first information in visible ink ..."

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5.2. "providing the first printed media with an identifier in invisible ink such that the designation of the identifier by the user using a reader interface module results in the reader interface module communicating a request for second information ..."

5.3. "such that the printer generates a second printed medium carrying said second information ..."

5.4. "account means for calculating, providing payments to the first party controlling the 1st DB by the second party controlling the second DB...".

6. With respect to 5.1 above, it is respectfully submitted that Intelligent Paper does not disclose a system for providing printed information to a user from a DB storage device in which the system includes a user printer module. It is respectfully submitted that Intelligent Paper does not anywhere disclose the use of a networked printer as a key component in a system for providing printed information to a user. Furthermore, Intelligent Paper does not disclose such a module being responsive to the user requesting first information from the first DB for generating a first printed medium that displays the first information in visible ink.

7. In support of the contention of 5.1, the Examiner has stated that: "All other claimed components are implicitly present in Intelligent Paper". With respect, Applicant submits that the Examiner has made use of hindsight to draw that conclusion. In particular, Applicant submits that it is necessary to interpret the Intelligent Paper with full knowledge of the "claimed components" in order to conclude that such components are implicitly present in the Intelligent Paper. Applicant submits that, according to MPEP 2141, Intelligent Paper must rather "be considered as a whole and must suggest the desirability and thus the obviousness of making the combination."

8. In support of the contention of 5.3, the Examiner has stated that the Intelligent Paper discloses at page 404, 2nd full paragraph that a user peripheral used to receive the linked information after pointing on the intelligent paper is a printer. The Examiner then states that the Intelligent Paper implicitly discloses that a second printed medium can be obtained via that printer.

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9. The relevant passage in Intelligent Paper reads as follows: "One possibility is to associate the peripheral with the pointer through a conventional computer dialogue, where the pointer's owner is asked to identify a certain communication port at a certain Internet address, if the peripheral is a computer display or a printer, ..." However, this passage deals with the use of "confetti" and how to identify a peripheral "close to the user". Applicant respectfully submits that, without using the invention as claimed as a reference, it is not possible to conclude that Intelligent Paper implicitly discloses that a second printed medium can be obtained via that printer.

10. In the requirements of MPEP 2141, it is set out that both the claimed invention and the prior art must be considered as a whole. In this regard, it is to be noted that the invention as claimed in claim 1 is concerned with a system that comprises the components of first and second data storage devices connectable to a network, a printer that is connectable to a network, an interface module and a calculation means. As described, these components interact to provide the claimed system.

12. It is respectfully submitted that the Examiner has selected various extracts from Intelligent Paper and simply arranged them to represent the system as claimed in claim 1. The Examiner has not stated why, when considered as a whole, those extracts should be combined. In particular, it is respectfully submitted that the Examiner has joined the extracts guided by the invention as claimed. As set out in MPEP 2141, this is not permissible.

13. For the purposes of the above paragraphs, claim 26 is the same as claim 1. Accordingly, the above arguments apply to claim 26 in the same manner. Claim 31 is a method for putting the systems of claims 1 and 26 into practice. It follows that the above arguments apply to claim 31 in the same manner.

14. In view of the above paragraphs, Applicant respectfully submits that the invention as claimed in claims 1, 26 and 31 is not obvious in view of Intelligent Paper.

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CONCLUSION

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application are courteously solicited.


Very respectfully,

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